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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,757	09/02/2005	Wayne A Jackson	PTB-4942-6	9205

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EXAMINER	
KIM, STEVEN S	

ART UNIT	PAPER NUMBER
3685	

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11/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/532,757	JACKSON ET AL.	
	Examiner	Art Unit	
	STEVEN KIM	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-76* is/are pending in the application.

4a) Of the above claim(s) *1-31 and 41-74* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-40,75 and 76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/19/07, 4/27/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the Restriction/Election response received on 10/27/2008 related to US Application No. 10/532,757, which was filed on 4/27/2005.

Status of Claims

2. Claims 1-76 are pending.

3. Claims 1-31 and 41-74 are withdrawn.

4. Claims 32-40, 75 and 76 have been examined.

Restriction/Election Acknowledgement

5. The Applicant's election on claims 32-40, 75 and 76 without traverse in the reply on October 27, 2008 is acknowledged. Claims 1-31 and 41-74 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group(s).

Priority

6. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/NZ02/00248 and 522453(NZ), filed November 5, 2003 and November 5, 2002 respectively. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e.,

continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111 (a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was

unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

7. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its i1nclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 32-40, 75 and 76 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. In regards to claims 32-40, based on Supreme Court precedent[1] and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.[2] If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

11. In this particular case, condition (1) is not met because there is no device or apparatus claimed that performs the process or method steps recited; and condition (2) is not met because there is no article or material being transformed by the method or process claimed. The Applicant(s) are encouraged to amend the claims to positively identify the device(s) or apparatus performing the method steps in order to have this rejection withdrawn.

12. As per claim 75, the claim is directed towards a system. However, the claim is dependent on claim 32 which is a method claim. Per § 101 statement as above, "whoever invents or discovers ant new and useful **process, machine, manufacture, or composition of matter**" may obtain a patient. Claim 75 is directed towards **a system and a method**.

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[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

13. As per claim 76, the claimed subject matter is related a "software". Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 32-40, 75 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Per claim 32, the term "other software product license data" is a relative term which renders the claim indefinite. The term "other software product license data" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

17. In further regards to claim 32, the claim recites "retrieving assessed use of the software products by the customer". It is unclear what is referenced **by the customer.** Is it the retrieving or the use of the software?

18. As per claim 33, the term "various assumptions" is a relative term which renders the claim indefinite. The term "various assumptions" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

19. As per claim 35, the claim recites "wherein the data in steps (i) to (iii) is retrieved from an analysis database" where steps (i) to (iii) are in reference to steps in claim 32. The above recited limitation contradicts claim 32 recited steps of "i) retrieving software product licensing data from a sales database; ii) retrieving other software product licence data from the customer".

20. As per claim 40, the term "more data or more reliable data" is a relative term which renders the claim indefinite. The term "more data or more reliable data" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

21. In regards to claims 75, the claim is directed to a system. The claim, however, is dependent on claim 32 which is a method claim. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide

competitors with an accurate determination of the 'metes and bounds' of protection involved-IPXL Holdings LLC v. Amazon.com Inc., 77 USPQ2d 1140 (CA FC 2005); Ex parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990)

22. Claims 33-40, 75 and 76 are rejected as described above since each depends on claim 32.

23. Claims 32-40, 75 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

24. In regards to claim 32, the claim recites "retrieving assessed use of software products". However, the claim does not include the step of assessing use of software product.

25. Claims 33-40, 75 and 76 are rejected as described above since each depends on claim 32.

Claim Rejections - 35 USC § 102

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

27. Claims 32-35, 37-39, 75 and 76 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 7,197,466, to Peterson et al., hereinafter referred to as "Peterson".

28. In regards to claims 32, 75 and 76, Peterson discloses a method of displaying a licence ownership position for a vendor's software products for a customer (see col. 1, lines 1-17, managing software assets using a database including license requirement; col. 5, lines 6-14, displaying component on a GUI) including the steps of:

- i) retrieving software product licensing data from a sales database (see Fig. 1, col. 1, lines 33-39; col. 3, lines 20-28; Fig. 4, Data base 20, Retrieving Component 87 and Accessing Component 84);
- ii) retrieving other software product licence data from the customer (see Fig. 1, Fig. 4, Data base 20, Receiving Component 83, Collection Component 80 and Accessing Component 84; col. 5, lines 15-25, update and retrieve information; col. 8, lines 37-41);
- iii) retrieving assessed use of the software products by the customer (see Fig. 5, Software Inventory Information Section; col. 5. lines 55-63; col. 7, lines 50-57);
- iv) calculating a licence ownership position (see Fig. 4, Data base 20, Processing Component 85; col. 7, lines 16-39; col. 7, lines 50-57; col. 11, lines 8-12); and
- v) displaying the licence ownership position and assumptions about calculations in a GUI (see Fig. 4, Display Component 88; col. 7, lines 50-57) .

29. As per claim 33, Peterson further discloses wherein the licence ownership position is calculated using one or more of the following factors the number/estimated number of computer users in the customer's organisation, the number of commercial licences sold to the customer (see Fig. 6, License Header fields including License_Total), the relationship between base licenses, upgrade licenses, and licences accrued via maintenance contracts, other licences owned by the customer, and various assumptions.

30. As per claim 34, Peterson further discloses wherein the licence ownership position is calculated by combining different licence types and aggregating purchases totals (see col. 6, lines 54-65; col./lines 7/50-8/4, col. 8, lines 29-32).

31. As per claim 35, Peterson also discloses wherein the data in steps (i) to (iii) is retrieved from an analysis database created by: i) receiving the data from a sales database (see Fig. 1, Fig. 4; Fig. 7, Sourcing or Procurement 396; col. 12, lines 54-57); and ii) collating the data into an analysis database (see Fig. 4).

32. As per claim 37, Peterson also teaches calculating and displaying the risk of non-compliance (see col. 2, lines 3-8, identify potential non-compliance; col. 7, lines 14-20; col. 7, lines 52-57).

33. As per claim 38, Peterson also discloses wherein step (vi) includes the step of comparing the licence ownership position to actual installation data or actual/estimated computer user data (see col. 12, lines 32-53, identifying software requirement and determining surplus software).

34. As per claim 39, Peterson discloses wherein the licence ownership position is recorded and used when later licence ownership positions are calculated (see col. 11, 8-12).

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

36. Claims 32-40, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 7,197,466, to Peterson et al., hereinafter referred to as "Peterson".

37. As per claim 36, Peterson does not specifically disclose wherein the sales database is the sales database of the vendor. However, the retrieving information from the vendor's database is old and well known in the art at the time of the invention as

evidenced by the Applicant's cited reference (see WO 00/52559 A1 page 13-14, reference to vendor's CDB).

38. It would have been obvious to one of ordinary skilled in the art to recognize that utilizing a direct feed from the vendor's database would provide data integrity.

39. As per claim 40, Peterson does not specifically disclose wherein the licence ownership position may be refined by providing more data or more reliable data. However, it is predictable that an operation will strive to use more reliable data in modeling to achieve more reliable results. Furthermore, the recited "may" is an optional language. see MPEP 2106 II.C

Conclusion

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 6,256,773: discloses a method and system for software management including License Management.
- US Patent No. 7,124,101: discloses network asset tracking and management system and methods.
- US Patent No. 6,735,701: discloses network policy compliance method and system.
- US Patent No. 7,430,590: discloses method and system for managing a group of services including software compliance reporting.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685